Remarks

Reconsideration of the above-identified application is respectfully requested. Claims 1-40 are pending in this application.

In the Office Action mailed June 24, 2004, the Examiner rejected claims 1-8, 11-18, 21-28 and 31-40 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,516,342 to Feldman et al. ("the '342 patent"). The Examiner still further rejected claims 9, 10, 19, 20, 29 and 30 under 35 U.S.C. §103(a) as unpatentable over the '342 patent.

For the reasons set forth in detail below, the Applicant respectfully traverses the Examiners rejections of the claims under 35 U.S.C. §§ 102(e) and 103(a).

Rejection of Claims 1-8, 11-18, 21-28 and 31-40 Under 35 U.S.C. §102(e)

As noted above, in the June 24, 2004 Office Action, the Examiner rejected claims 1-8, 11-18, 21-28 and 31-40 under 35 U.S.C. §102(e) as anticipated by the '342 patent. The Applicant believes, however, that those claims are not anticipated by that reference.

The Applicant's claimed invention is directed to a system and method for remotely configuring data storage space. As set forth in independent claims 1, 11, 21, 31 and 36, a plurality of storage devices have storage space comprising free storage space and allocated storage space. The allocated storage space is to be allocated to a remote user for storing user data. A portion of the free storage space may be automatically transferred to the allocated storage space, or a portion of the allocated storage space can be automatically transferred to the free storage space in response to a manually initiated user request to increase or decrease the size of the allocated storage space.

The '342 patent is directed to a method and apparatus for extending memory using a memory server. The memory server provides additional memory to a network connected computer, which may be referred to as a network client, when the network client's

local memory is insufficient for a particular application. As a result, applications that could not be executed in a memory constrained environment, such as the network client, can be executed using the memory server. (*See, e.g.*, The '342 Patent, col. 2, ll. 45-62.)

According to the '342 patent, interaction with the memory server begins automatically when the memory requirements of an application exceed that of the network client's local memory. Additionally, interaction with the memory server ends automatically when the memory requirements of the application are reduced to within the limits of the network client's local memory. (*See, e.g.*, The '342 Patent, col. 4, ll. 26-38.) As is readily apparent, then, the memory server of the '342 patent automatically provides additional memory to the network client as needed for use in a particular application.

In contrast to the '342 patent, the Applicant's claimed invention is directed to configuring storage space allocated to a user for storing data from the user. Rather than a network client, the user is an individual at a remote site. According to the Applicant's claimed invention, a portion of free storage space is automatically transferred to the user's allocated storage space, or a portion of the user's allocated storage space is automatically transferred to free storage space in response to a manually initiated request by the remote user to increase or decrease the size of the user's allocated storage space.

In the June 24, 2004 Office Action, the Examiner contends that the '342 patent discloses manual initiation of a request for increasing or decreasing allocated storage space because even though interaction with the memory server begins and ends automatically, that interaction is the result of "manual initiation of user data and programs and user adjustments of programmed application parameters." Every "automatic" action can be traced back to some earlier manual cause, even if that manual cause was simply the installation of a device or software. In that sense, no action can be described as "automatic." Instead, every action must be described as "manual." Such an interpretation, however, renders the terms "manual" and "automatic" meaningless. To the contrary, though, each of those terms has a meaning in the art which is well known and understood. Indeed, the '342 patent describes interaction with

the memory server as beginning and ending automatically in order to distinguish manual interaction.

The Applicant therefore believes that independent claims 1, 11, 21, 31 and 36 are not anticipated by the '342 patent. Accordingly, reconsideration of the Examiner's rejection thereof under 35 U.S.C. §102(e) is respectfully requested.

Claims 2-8, 12-18, 22-28, 32-35 and 37-40 depend either directly or indirectly from independent claims 1, 11, 21, 31 and 36, respectively, and include all the limitations thereof. As a result, and for the reasons set forth above concerning claims 1, 11, 21, 31 and 36, the Applicant believes that claims 2-8, 12-18, 22-28, 32-35 and 37-40 likewise overcome the Examiner's rejection thereof under 35 U.S.C. §102(e), and reconsideration of that rejection is also respectfully requested.

Rejection of Claims 9, 10, 19, 20,
29 and 30 Under 35 U.S.C. §103(a)

As also noted above, in the June 24, 2004 Office Action, the Examiner also rejected claims 9, 10, 19, 20, 29 and 30 Under 35 U.S.C. §103(a) as unpatentable over the '342 patent. The Applicant believes, however, that those claims are not rendered obvious by that reference.

More specifically, as demonstrated above, the '342 patent fails to anticipate independent claims 1, 11, 21. Claims 9, 10, 19, 20, 29 and 30 depend either directly or indirectly from independent claims 1, 11 and 21, respectively, and include all the limitations thereof. As a result, and for the reasons set forth above concerning claims 1, 11 and 21, the claims 9, 10, 19, 20, 29 and 30 are not rendered obvious by the '342 patent.

Accordingly, reconsideration of the Examiner's rejection of claims 9, 10, 19, 20, 29 and 30 is respectfully requested.
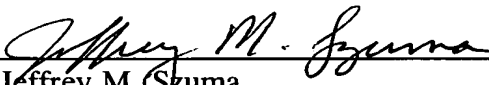
Conclusion

For the foregoing reasons, the Applicants believe that claims 1-40 meet both the formal and substantive requirements for patentability, and that the application is in condition for allowance. Accordingly, such action by the Examiner is respectfully requested.

If a telephone conference would expedite allowance or resolve any additional questions, such a call is invited at the Examiner's convenience.

Respectfully submitted,

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